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Filing date: **01/14/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91263510
Party	Plaintiff Traxxas, L.P.
Correspondence Address	GREGORY CARR CARR LAW FIRM PLLC 6170 RESEARCH ROAD SUITE 111 FRISCO, TX 75033-3512 UNITED STATES Primary Email: gcarr@carrip.com Secondary Email(s): trademarks@carrip.com 2147603030
Submission	Motion to Compel Discovery or Disclosure
Filer's Name	David C. Huang
Filer's email	dhuang@carrip.com, trademarks@carrip.com, gcarr@carrip.com
Signature	/David C. Huang/
Date	01/14/2021
Attachments	Traxxas LP v. Mattel Inc - Motion to Compel Initial Disclosures 1-14-2021.pdf(915586 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TRAXXAS, L.P.	§	Opposition No.: 91263510
	§	
Opposer	§	
	§	
v.	§	
	§	
Mattel, Inc.	§	
	§	
Applicant	§	Application No.: 88583445
	§	Mark: MIGHTY MAX

**OPPOSER TRAXXAS, L.P.'S MOTION TO COMPEL FULL AND COMPLETE
INITIAL DISCLOSURES BY APPLICANT**

Opposer Traxxas, L.P. (“Opposer”), hereby moves to compel full and complete initial disclosures by Applicant Mattel, Inc. (“Applicant”) in compliance with Fed. R. Civ. P. 26(a)(1). Attached as Exhibit A is a copy of Applicant’s Initial Disclosures served on December 14, 2020 (“Initial Disclosures”). This motion is filed timely, on the thirtieth (30th) day following the December 15, 2020 deadline for service of initial disclosures in this proceeding.

On December 28, 2020, Opposer gave notice that Applicant’s Initial Disclosures were deficient because only “Mattel” and “Opposer” were identified as witnesses, without identifying any individuals as witnesses. Opposer made a request for supplementation as well. A copy of the notice to Applicant is attached as Exhibit B. On January 6, 2021, Applicant responded to Opposer’s notice indicating that unless Opposer provided further TTAB opinions or opinions from federal courts interpreting TBMP 401.02 or FRCP 26(a)(1), it believed the Initial Disclosures it served were complete in accordance with FRCP 26(a)(1)(A)(i). In response, on January 7, 2021, Opposer indicated to Applicant that it disagreed with Applicant and maintained that further identification of individuals likely to have discoverable information in the Initial

Disclosure is necessary. Since then, Applicant has given no indications to Opposer that any further supplementary initial disclosures would be forthcoming to address Opposer's concern expressed in its original notice. A copy of the correspondence between Applicant and Opposer is attached as Exhibit C. As of the filing of this motion, Applicant has not served Initial Disclosures in full compliance with Fed. R. Civ. P. 26(a)(1).

Pursuant to TBMP 401.02 and Fed. R. Civ. P. 26(a)(1)(A)(i), Applicant is required to disclose "the name and, if known, the address and telephone number of each **individual** likely to have discoverable information - along with the subjects of that information – that [respondent] may use to support its claims or defenses" (Emphasis added). *Influence, Inc. v. Elaina Zuker*, 88 U.S.P.Q.2D (BNA) 1859, 1860-1861 (TTAB 2008).

The Initial Disclosures are deficient in that Applicant has failed to identify the names and (if known) the address and telephone number of each **individual** likely to have discoverable information. Specifically, in the left column of the table on pages 2-3 of the Initial Disclosures, Applicant merely names "Mattel" and "Opposer" as potential witnesses without giving any names or addresses for any individuals. Applicant's disclosure of "Mattel" and "Opposer" as individuals having discoverable information is therefore improper and so general and ambiguous as to be of little use to Opposer in advancing the purpose for and intent of initial disclosures.

Opposer therefore requests an order compelling Applicant to supplement its Initial Disclosures with the identity of individuals (regardless of any association with Mattel and Opposer) Applicant believes are likely to have discoverable information. Opposer also requests that Applicant be ordered to provide the address and telephone number (if known) for any identified individual who is not represented by Opposer's counsel. In the event, however, the

identity of such individuals are presently unknown to Applicant, Opposer requests an order requiring Applicant to remove the contents of the table on pages 2-3 of the Initial Disclosure.

Dated: January 14, 2021

Respectfully Submitted,

/s/ David C. Huang

Gregory W. Carr
David C. Huang
Attorneys for Opposer
Carr Law Firm PLLC
6170 Research Road
Suite 111
Frisco, Texas 75033
Telephone: (214) 760-3000
Email: gcarr@carrip.com

CERTIFICATE OF SERVICE

I hereby declare under penalty of perjury that **on January 14, 2021** a true copy of the foregoing OPPOSER TRAXXAS, L.P.'S MOTION TO COMPEL FULL AND COMPLETE INITIAL DISCLOSURES BY APPLICANT was served **via email** on **Jill M. Pietrini** at Sheppard Mullin Richter & Hampton LLP, 1901 Avenue of the Stars, Suite 1600, Los Angeles, CA 90067, attorney of record for Applicant, sent to the addresses noted below:

trademarkscc@sheppardmullin.com;

jpietrini@sheppardmullin.com;

rlhudson@sheppardmullin.com;

PBost@SheppardMullin.com; and

MDaner@SheppardMullin.com

/s/ David C. Huang
David C. Huang
Attorney for Opposer

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<i>In re Matter of Application No. 88/583,445 for the mark: MIGHTY MAX in Class 28</i> Traxxas, L.P., Opposer, vs. Mattel, Inc., Applicant.	Opposition No. 91-263510 APPLICANT MATTEL, INC.’S INITIAL DISCLOSURES
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Pursuant to 37 C.F.R. § 2.120 (a) and Federal Rule of Civil Procedure (“Fed.R.Civ.P.”) 26(a)(1), Applicant Mattel, Inc. (“Mattel”) hereby makes the following initial disclosures to Opposer Traxxas, L.P. (“Opposer”).

I. RESERVATIONS

Mattel’s initial disclosures are made without waiver of, or prejudice to, any objections that Mattel may have. Mattel expressly reserves all such objections, including but not limited to: (a) relevance; (b) attorney-client privilege; (c) work-product protection; (d) any other applicable privilege or protection under federal or state law; (e) undue burden; (f) materiality; (g) overbreadth; (h) the admissibility in evidence of these initial disclosures or the subject matter thereof; (i) proprietary and confidential business information, financial data, and trade secrets that belong either to Mattel or to individuals and entities with whom Mattel conducts, or has conducted, business; and (j) documents containing information disclosed or transmitted to any

state or federal agency, to the extent such information is confidential and not required to be disclosed under applicable law. All objections are expressly preserved, as are Mattel's rights to move for entry of a protective order.

Mattel makes these disclosures based upon information reasonably available at this time. Mattel has not completed its discovery in this case and has not completed preparation for its testimony period. Accordingly, these initial disclosures are provided without prejudice to Mattel's right to introduce during its testimony period any evidence that is subsequently discovered. Mattel reserves the right to clarify, amend, modify, or supplement the information contained in these initial disclosures in accordance with the TBMP, the Fed.R.Civ.P., and the Trademark Rules of Practice.

II. WITNESSES

Mattel is aware of the following persons likely to have discoverable information that Mattel may use to support its claims and defenses. All of Mattel's witnesses identified below shall be contacted through counsel, Jill M. Pietrini, Sheppard, Mullin, Richter & Hampton LLP, 1901 Avenue of the Stars, Suite 1600, Los Angeles, CA 90067-6055, Telephone: (310) 228-3700, Facsimile: (310) 228-3701:

<u>Mattel's Witnesses</u>	<u>Opposer's Witness</u>
FRCP 30(b)(6), Mattel <i>Subject matter:</i> Mattel's use of the MIGHTY MAX mark; coexistence of Mattel's MIGHTY MAX mark with the MAXX Marks (as defined herein) without actual confusion; coexistence of Opposer's lapsed MIGHTY MAX registration with Opposer's registrations of the MAXX Marks on the Principal Register; the goods offered and intended to be offered by Mattel under the MIGHTY MAX mark; the	FRCP 30(b)(6), Opposer <i>Subject matter:</i> Opposer's allegations set forth in its first amended notice of opposition; Opposer's use and registrations of MAXX, T-MAXX, E-MAXX, MINI MAXX, X-MAXX, and XMAXX (the "MAXX Marks"); coexistence of Mattel's use of MIGHTY MAX mark with MAXX Marks without actual confusion; coexistence of Opposer's lapsed MIGHTY MAX registration with Opposer's

<u>Mattel's Witnesses</u>	<u>Opposer's Witness</u>
marketing and advertising and intended marketing and advertising of goods offered under the MIGHTY MAX mark; and third-party uses of marks including the term MAX, MAXX, and variations thereof.	registrations of the MAXX Marks on the Principal Register; Opposer's selection of the MAXX Marks; goods offered by Opposer under the MAXX Marks and the customers to whom and channels of trade in which such goods or services are offered; the wholesale and retail price of Opposer's goods offered under the MAXX Marks; the revenue generated from Opposer's sale of goods under the MAXX Marks; Opposer's expenses related to the advertising and promotion of goods offered under the MAXX Marks; Opposer's policing of the MAXX Marks; Opposer's litigation and disputes relating to the MAXX Marks; Opposer's dispute and settlement discussions with Creative Impact Inc. and Zuru (Singapore) PTE Ltd.; and all agreements Opposer has entered into relating to the MAXX Marks.

III. DOCUMENTS

The following categories of documents and things are in Mattel's custody, control, or possession and may be used by Mattel to support its claims in this action.

<ul style="list-style-type: none"> • Documents from www.uspto.gov regarding Mattel's and Opposer's trademark registrations and applications at issue in this action
<ul style="list-style-type: none"> • Exemplars, photographs, and screen-captures of Mattel's products bearing the MIGHTY MAX mark
<ul style="list-style-type: none"> • Advertisements and promotional materials showing Mattel's use of the MIGHTY MAX mark
<ul style="list-style-type: none"> • Publicity regarding goods offered under the MIGHTY MAX mark by Mattel
<ul style="list-style-type: none"> • Exemplars, photographs, and screen-captures of Opposer's products bearing its alleged MAXX formative trademarks
<ul style="list-style-type: none"> • Documents reflecting third-party use of marks including the term MAX, MAXX, and variations thereof
<ul style="list-style-type: none"> • Documents and things produced by Mattel in this action

- Documents and things produced by Opposer in this action

Dated: December 14, 2020

/Paul A. Bost/
Jill M. Pietrini
Paul A. Bost
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

Attorneys for Mattel, Inc.

CERTIFICATE OF SERVICE

I hereby certify that this **APPLICANT MATTEL, INC.'S INITIAL DISCLOSURES** is being transmitted via email to gcarr@carrip.com and trademarks@carrip.com on this 14th day of December, 2020.

/Paul A. Bost/
Paul A. Bost

SMRH:4838-0740-6546.1

Exhibit B

David Huang

From: David Huang
Sent: Monday, December 28, 2020 4:48 PM
To: Paul Bost
Cc: Jill Pietrini; Greg Carr; trademarks; Beth Anderson
Subject: Re: Traxxas, L.P. v. Mattel, Inc. - Deficiencies of Applicant's Initial Disclosures
Attachments: Initial Disclosures - Traxxas v. Mattel.pdf



David C. Huang
Attorney and Counselor
6170 Research Road
Suite 111
Frisco, Texas 75033
Direct: 214.760.3005
www.CarrIP.com

Re: Traxxas, L.P. v. Mattel, Inc.
Opposition No. 91263510

Dear Paul,

Attached is a copy of the Initial Disclosures Mattel, Inc. (Applicant) served on Traxxas, L.P. (Opposer) on December 14, 2020 ("Initial Disclosures"). The Initial Disclosures contain deficiencies on their face that require supplementation. Please provide us with supplemental Initial Disclosures fully addressing our requests below by **January 7, 2021**.

The Initial Disclosures are deficient in that for witnesses identified in the Initial Disclosures, Mattel is required to identify the names and (if known) the address and telephone number of each **individual** likely to have discoverable information. See TBMP 401.02 and FRCP 26(a)(1). Specifically, in the table on pages 2-3 of the Initial Disclosures, **no names or addresses for any individuals are given by Mattel**. Pursuant to the Initial Disclosure requirements as set out by the Board, if Mattel decides to identify any witnesses it believes are likely to have discoverable information in its Initial Disclosures, Mattel is required to identify at least the name of the individual and the subject matter(s) the identified individual is likely to have discoverable information about. As such, the naming of "Mattel" and "Opposer" as witnesses is not proper in initial disclosures before the Board. Please supplement the Initial Disclosures with the names and (if known) the address and telephone number of each **individual** Mattel believes is likely to have discoverable information. If, however, the identity of such individuals is presently unknown, please so state or remove the table from the disclosures.

Your prompt supplementation will be greatly appreciated and will avoid the need to file a motion to compel. Please let us know immediately if you have any questions.

Regards,

David Huang

Protecting your share of the marketplace.®

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Exhibit C

David Huang

From: Greg Carr
Sent: Thursday, January 7, 2021 8:47 AM
To: Paul Bost
Cc: trademarks; David Huang; Jill Pietrini; Beth Anderson
Subject: RE: Traxxas, L.P. v. Mattel, Inc. - Deficiencies of Applicant's Initial Disclosures

Paul:

We disagree. You have perhaps described categories of individuals, but that is not sufficient. Identification is necessary.

Also, one of many various and sometimes conflicting meanings of your description is Mattel is aware of no individuals to be identified. On the other hand, another meaning is that all offices, directors and managing agents of Mattel are identified.

We will see whether the TTAB agrees with your position.

Regards,
Greg

From: Paul Bost <PBost@sheppardmullin.com>
Sent: Wednesday, January 06, 2021 4:13 PM
To: Greg Carr <gcarr@carrip.com>
Cc: trademarks <trademarks@carrip.com>; David Huang <dhuang@carrip.com>; Jill Pietrini <JPietrini@sheppardmullin.com>; Beth Anderson <baanderson@sheppardmullin.com>
Subject: RE: Traxxas, L.P. v. Mattel, Inc. - Deficiencies of Applicant's Initial Disclosures

Hi, Greg:

In the future, please reply all to my emails instead of removing members of our team.

Mattel has identified individuals "likely to have discoverable information ... that the disclosing party may use to support its claims or defenses." FRCP 26(a)(1)(A)(i). These individuals are the "one or more officers, directors, or managing agents, or designate other persons who consent to testify" on Mattel's and Traxxas' behalves regarding the identified subject matter. FRCP 30(b)(6). Also, we *did* provide an address for Mattel's witnesses: "All of Mattel's witnesses identified below shall be contacted through counsel, Jill M. Pietrini, Sheppard, Mullin, Richter & Hampton LLP, 1901 Avenue of the Stars, Suite 1600, Los Angeles, CA 90067-6055, Telephone: (310) 228-3700, Facsimile: (310) 228-3701." Notably, Opposer also identified its counsel's address for its witnesses in its initial disclosures.

If I understand your email below correctly, you are not aware of any TTAB opinions or opinions from federal courts interpreting TBMP 401.02 or FRCP 26(a)(1) to prohibit identifying a 30(b)(6) representative(s) in initial disclosures. I have researched the issue and, likewise, am not aware of any such authority. If you become aware of any such authority, please provide it and we will, of course, reconsider the issue.

Best,

Paul

Paul Bost

+1 310-228-2249 | direct

PBost@sheppardmullin.com | [Bio](#)

SheppardMullin

1901 Avenue of the Stars, Suite 1600

Los Angeles, CA 90067-6017

+1 310-228-3700 | main

www.sheppardmullin.com | [LinkedIn](#) | [Twitter](#)

From: Greg Carr <gcarr@carrip.com>

Sent: Tuesday, January 5, 2021 5:43 PM

To: Paul Bost <PBost@sheppardmullin.com>

Cc: trademarks <trademarks@carrip.com>; David Huang <dhuang@carrip.com>

Subject: RE: Traxxas, L.P. v. Mattel, Inc. - Deficiencies of Applicant's Initial Disclosures

Paul:

Thank you for your response. The supporting authority is cited in our email below. A corporation is not an "individual."

I believe the burden is now on you to cite authority to the contrary, if you disagree.

Regards,
Greg

From: Paul Bost <PBost@sheppardmullin.com>

Sent: Tuesday, January 05, 2021 2:46 PM

To: David Huang <dhuang@carrip.com>

Cc: Jill Pietrini <JPietrini@sheppardmullin.com>; Greg Carr <gcarr@carrip.com>; trademarks <trademarks@carrip.com>;

Beth Anderson <baanderson@sheppardmullin.com>

Subject: RE: Traxxas, L.P. v. Mattel, Inc. - Deficiencies of Applicant's Initial Disclosures

Dear David:

We're considering your letter. Are you aware of authority holding that Mattel's identification of a 30(b)(6) witness(es) is an improper disclosure?

Best,

Paul

Paul Bost

+1 310-228-2249 | direct

PBost@sheppardmullin.com | [Bio](#)

SheppardMullin

1901 Avenue of the Stars, Suite 1600

Los Angeles, CA 90067-6017

+1 310-228-3700 | main

www.sheppardmullin.com | [LinkedIn](#) | [Twitter](#)

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Beth Anderson <baanderson@sheppardmullin.com>
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David C. Huang
Attorney and Counselor
6170 Research Road
Suite 111
Frisco, Texas 75033
Direct: 214.760.3005
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Re: Traxxas, L.P. v. Mattel, Inc.
Opposition No. 91263510

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Regards,

David Huang

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